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Scott A. Burton

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06/04/2008

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EXAMINER

RONESI, VICKEY M

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

06/04/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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***Attachment to Advisory Action***

Applicants' amendment filed on 5/19/2008 has been fully considered; however, the amendment has not been entered given that it introduces the issue of new matter.

With respect to the issue of new matter, claim 53 recites that the organic polymer matrix is liquid at room temperature. It is the examiner's position that this phrase fails to satisfy the written description requirement of 35 USC 112, first paragraph since there does not appear to be a written description requirement of the phrase "the organic polymer matrix is liquid at room temperature" in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. While there is support for a composition comprising an organic polymer matrix and a dispersion comprising hydrophilic microparticles and a hydrophobic liquid phase on page 10, lines 4-6 of the specification, there is no support for the organic polymer matrix being a liquid at room temperature.

Furthermore, claim 55 recites that the organic polymer matrix is solid at room temperature. It is the examiner's position that this phrase fails to satisfy the written description requirement of 35 USC 112, first paragraph since there does not appear to be a written description requirement of the phrase "the organic polymer matrix is solid at room temperature" in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

In the interest of better enabling the applicants to assess the patentability of their claims, the following advisory is given:

Art Unit: 1796

Applicant's response filed on 5/19/2008 has been fully considered but is not persuasive.

Specifically, applicant argues that Highgate requires the composition to have sealing properties and therefore cannot read on the presently claimed "nonadherent" composition.

In response, it is the examiner's position that "sealing" is not the same as "adhering." A seal ensures that the connection is tight, but one cannot presume because that the seal is bonded (as required by an adhesive) to the adjacent surface. For example, a gasket is used to seal a joint between two pipes to make it watertight but the seal could be easily removed when the mechanism holding the pipes in place is removed. Furthermore, even Highgate provides a distinction between a seal and an adhesive by stating that adhesive properties can be imparted by adding a tackifier.

5/29/2008

Vickey Ronesi

/V. R./

Examiner, Art Unit 1796

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Supervisory Patent Examiner, Art Unit 1796